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In re Application of	:	OFFICE OF PETITIONS
Walker et al.	:	
Application No. 09/609,931	:	DECISION ON PETITIONS
Filed: June 30, 2000	:	
Attorney Docket No. 99-099	:	

This is a decision on the petition under 37 CFR 1.48(a), filed June 3, 2005, to add persons as inventors of the above-identified application. This is also a decision on the petition under 37 CFR 1.183, filed June 3, 2005, to waive 37 CFR 1.48(a)(3), which requires the actual inventors to execute an oath or declaration in compliance with 37 CFR 1.63. The petitions were recently forwarded to the Office of Petitions for a decision on the merits. The Office sincerely apologizes for any inconvenience to petitioner.

On June 30, 2000, petitioner filed the above-identified application, including a properly executed declaration. On June 3, 2005, petitioner filed a petition to add Daniel E. Tedesco, Andrew S. Van Luchene, and John B. Dickerson as joint inventors in the above-identified application. Petitioner stated that inventor, Anna Rath, who executed the original declaration, refused to execute the declaration submitted with the petition pursuant to 37 CFR 1.48(a)(3).

Petition Under 37 CFR 1.183

In the present petition, petitioner asserted that inventor, Anna Rath, who executed the original declaration, refused to execute the declaration submitted with the petition pursuant to 37 CFR 1.48(a)(3). Thus, petitioner requested that the Office waive the requirement of 37 CFR 1.48(a)(3).

Pursuant to 37 CFR 1.183, in an extraordinary situation, when justice requires, any requirement of the regulations, which is not a requirement of the statutes, may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party. In support of petitioner's assertion of Ms. Rath's refusal, petitioner submitted the Affidavit of Michael D. Brinton. Mr. Brinton stated that he mailed a copy of the application papers, including the drawings, a Combined Declaration and Power of Attorney, an Assignment, and a self-addressed stamped envelope to Ms. Rath at her last known address. Additionally, Mr. Brinton attested that he left a telephone message for Ms. Rath at her place of employment; however, she did not contact him or executed the requested documents.

In view of the fact that Ms. Rath refused to sign the declaration, it is agreed that justice would be served by waiving the requirement of 37 CFR 1.48(a)(3).

Accordingly, the petition under 37 CFR 1.183 is **granted**.

Petition Under 37 CFR 1.48(a)

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

Although the petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.48(a)(3) is granted, the petition lacks item (5) above.

Section 201.03(II)(D) of the Manual of Patent Examining Procedure states, in pertinent part: "The written consent of every existing assignee of the original named inventors must be submitted. 37 CFR 1.48(a)(5)." MPEP 201.03(II)(D). "37 CFR 1.48(a) does not limit assignees to those who are recorded in the U.S. Patent and Trademark Office record." *Id.* "The individual signing on behalf of the assignee giving its consent to the requested inventorship correction, should specifically state that he or she has the authority to act on behalf of the assignee." *Id.* "Further, the assignee must establish its ownership of the application in accordance with 37 CFR 3.73. MPEP § 324." *Id.*

In the present petition, the assignee established its ownership of the application in accordance with 37 CFR 3.73. However, a review of the record does not indicate that that petitioner submitted the written consent of the assignee with the present petition in compliance with 37 CFR 1.48(a)(5).

Accordingly, the petition under 37 CFR 1.48 is **dismissed**.

The \$400.00 fee for filing the petition under 37 CFR 1.183 and the \$130.00 processing fee for the petition under 37 CFR 1.48 will be charged to petitioner's Deposit Account, as authorized.

Petitioner is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the above-noted deficiency. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.48." Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

Further correspondence with respect to this matter should be addressed as follows and **to the attention of Senior Petitions Attorney Christina Tartera Donnell:**

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Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

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